

REMARKS

I. Introduction

The Office Action mailed September 15, 2009, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance.

II. Status of the Claims

Claims 1, 7, 9-10, 12, and 16-18 are pending. Claims 2-6, 8, 11, and 13-15 have been cancelled. Claim 7 has been amended to depend from claim 1.

III. Summary of the Office Action

In the Office Action, the Examiner objected to claim 8 for failure to narrow the parent claim. This objection is moot because claim 8 has been cancelled.

The Examiner also rejected the claims as follows:

- 1) claims 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for being dependant from a cancelled claim; and
- 2) claims 1, 7-10, 12, and 16-18 under 35 U.S.C. § 103(a) as being obvious over Doen et al. (U.S. 2003/0191157).

IV. Arguments

Applicant respectfully traverses the rejections for the following reasons:

A. Claim 7 is not indefinite

Claim 7 stand rejected for being dependent from a cancelled claim. Claim 7 has been amended to depend from independent claim 1. Therefore, Applicants respectfully request withdrawal of the rejection.

B. The claims are not obvious

Claims 1, 7-10, 12, and 16-18 stand rejected as being obvious over Doen et al. The Examiner alleges that although Doen et al. do not disclose the rabeprazole to alkaline compound ratio of about 1:0.359, “generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical.” Office Action, page 7.

Even though Applicants believe that the Examiner has failed to produce a *prima facie* case of obviousness, in the interest of compact prosecution, Applicants respectfully submit that the claimed invention produces unexpected results sufficient to over come any *prima facie* case. Applicants file herewith a Declaration Under 37 C.F.R. §1.132 (Declaration) by Mr. Bharat Babulal Shah comparing a composition using the rabeprazole to alkaline compound ratio of the present invention (1:0.359) to the composition using the ratio taught by Doen et al. (1:1). As noted in the Declaration, the composition of the present invention produces a composition that has significantly higher solution stability. The data presented in the Declaration shows that, after 1 hour, the composition of Doen et al. is also outside of the desired stability specification. The composition of the present invention, on the other hand, is much more stable and is well within the desired stability range. This discovery is unexpected from the teaching of the prior art.

Therefore, the invention is not obvious, "because that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious." *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

V. Conclusion

Applicants have responded to the Office Action mailed September 15, 2009. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (125139.0101). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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